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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,111	01/10/2002	Richard Edmond Berry	AUS920010994US1	2389
35525	7590	06/20/2007		EXAMINER
IBM CORP (YA)				NGUYEN, CAM LINH T
C/O YEE & ASSOCIATES PC				
P.O. BOX 802333			ART UNIT	PAPER NUMBER
DALLAS, TX 75380			2161	
			MAIL DATE	DELIVERY MODE
			06/20/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/045,111
Filing Date: January 10, 2002
Appellant(s): BERRY, RICHARD EDMOND

MAILED

JUN 20 2007

Technology Center 2100

Gerald H. Glanzman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/5/2006 appealing from the Office action mailed 1/3/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 43 – 44, 46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 43 – 44, 46 are not statutory, directed to a computer program product in a computer readable medium. Appellant defined the terms “computer

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readable medium" can be included light wave transmissions, wireless communication (See detail description in page 24). Therefore, claims 43 – 44, 46 do not result in a physical transformation, or physically implemented in a hardware computer nor do they appear to provide a useful, concrete and tangible result. Claims 43 – 44, 46 directed to software, per se, lacking storage a medium that enables any underlying functionality to occur. Therefore, claims 43 – 44, 46 appear non-statutory.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,253,204	GLASS	06-2001
20030191737	STEELE	10-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 12, 16- 21, 23 – 35, 39 – 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glass et al (U.S. 6,253,204 B1) in view of Steel et al (U.S. 2003/0191737 A1).

◆ As per claims 1, 8, 20 – 21, 24, 31, 43 – 44,

Class et al discloses a method in a data processing system for pruning search engine indices, comprising:

- “Receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords” See Fig. 2 – 3, col. 5, lines 35 – 40, col. 8, lines 61 - 65.

In particular,

- Client browser: Glass teaches an old server-client system (see Fig. 2, col. 4, lines 23 – 37). A user requests a document such as “document 1” from the Web. The user must use a browser to retrieve document from the WWW. The browser is inherent in Glass reference. Even if the browser is not inherent, the Examiner provides an evident that it is well known in the art, the user must use a browser to view document from the Web (see Steel et al, Fig. 8, paragraph 0125). In the interest of prosecution, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a browser as taught by Steel into the invention of Glass because the teaching would provide good presentation or viewing a document using a browser.
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- Keywords: The request that contains “document 1” is inputted to the browser. Therefore, “document1” corresponds to a keyword. After that “document 2” is also another keyword, when the user tries to retrieve it. The user is notified if the file is not found, and the browser automatically generates a message to send to the server (fig. 3, step 340). It is well known in the art that the query contains search terms where the search term is equivalent to the keywords. An evident is submitted by Steel et al (See Fig. 15A, paragraph 0151, of Steel).
- Search Engine: Glass also teaches that a spider can be utilized (see the abstract, col. 7, lines 59 – col. 8, lines 2). A spider can be located in the server (col. 8, lines 55 – 65). By definition of Microsoft Computer dictionary, Fifth Edition, the term “spider” is an automated program that searches the Internet for documents and indexes their addresses and content related information in a database and also

called search engine or crawler. Therefore, this spider is considered equivalent with the “search engine” in the instant application. Since it is a program, the spider can be located in the server side of the system or client side or in the middle such as central system to search for information in the network. Therefore, as discussed above, the user send a message to the server and the spider receives it. A client reports the broken link to the server in which a spider located (as discussed above) (see col. 7, lines 15 – 16, 57 - 59).

Glass teaches that the server will modify the broken link in order to restore the link or delete a record after a period of time (see col. 8, lines 43 – 48).

Glass does not clearly teach that the system will “automatically deleting the Web page from the search engine indices in response to receiving the notification”. However, Steel discloses a retrieving information system that allows a user view a website. Steel discloses a search engine that search the central index (paragraph 0073). In addition, plurality of remote servers also disclose, where each server contains an index (See Fig. 5, of Steel). The Steel system has a capability of deleting the URL in their index if an error occurs in the central server or the sub server (paragraph 0082, 0094, and 0113 of Steel).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the system of Glass by apply the teaching of Steel for deleting the web page from a search engine index because the combination would keep the record up-to-date, and reduce the time/cost searching for other user in later time.

- ◆ As per claims 2, 9, 25, 32, Glass and Steel disclose:

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- “The step of automatically deleting is initiated if the notification results in a minimum number of notifications being received for the Web page” See Fig. 10, col. 6, lines 62 – col. 7, lines 4, Fig. 12A – B, col. 7, lines 13 - 48 of Glass.
- ◆ As per claims 3, 10, 26, 33, 37, Glass and Steel disclose:
 - “Receiving a search request from the client browser, wherein the search request contains the selected keywords” See Fig. 2, element 200, col.4, lines 25 – 35, Glass, and see Fig. 15A, paragraph 0151, of Steel.
 - “Searching the search engine indices for matches to the selected keywords to form a search” See Fig. 2, element 210 – 20, Glass, and see Fig. 15A, element 1506, paragraph 0151, of Steel.
 - “Sending a result of the search to the client browser” See Fig. 2, element 240, Glass.
- ◆ As per claims 4, 27, Glass and Steel disclose:
 - “The search result includes an indication that the data processing system includes a search engine to cause the client browser to send the notification to the data processing system” See Fig. 2, element 260, Fig. 3, Glass.
- ◆ As per claims 5, 28, Glass and Steel disclose:
 - “The search request includes other keywords in addition to the selected keywords” See Fig. 2 of Glass. The request that includes document 1 is an example of keywords. The document 1, may contains hypertext that identifies another document. This hypertext is also considered as another keyword that included in the search request.
- ◆ As per claims 6, 11, 14, 29, 34, Glass and Steel disclose:

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- “The retrieval error indicates that the Web page is absent” See col. 4, lines 40 – 55, Glass.
- ◆ As per claims 7, 12, 15, 30, 35, 38, Glass and Steel disclose:
 - “The method is located in one of a search engine or a Web portal” See Fig. 1D, Glass.
- ◆ As per claims 16, 23, 39, 46, Glass and Steel disclose:

The combination of Glass and Nielsen disclose the limitation of determining an error in retrieving the web page, and removing the web page in response to the error. In addition, Steel also discloses a method for maintain a bookmark in the user system (See paragraph 0125 of Steel)
- ◆ As per claims 17 - 19, 40 – 42,

Claims 17 – 19, 40 – 42, are rejected based on the rejection of claims 2 and 9.

(10) Response to Argument

In Appellant’s Brief, filed June 5, 2006, Appellant argues two specific points:

- 1) The Examiner has not established a prima facie case of obviousness in rejecting claims of the present application.
- 2) The combination of Glass and Steele does not disclose “automatically deleting the web page from the search engine indices” in response to “receiving a notification by the search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords”

The Federal Circuit has embraced a theory of prima facie obviousness for use in ex parte prosecution in the PTO. The prima facie case is a procedural tool that, as used in patent examination, means not only that the evidence of the prior art would reasonably allow the

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conclusion that the examiner seeks, but also that the prior art compels such a conclusion if the Appellant produces no evidence or argument to rebut it. See *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). In the instant case, the prior art compels the conclusion that the claimed invention is unpatentable under 35 U.S.C. §103(a) as set forth in the Final Office Action, mailed January 3, 2006, and reiterated above for convenience.

Each of Appellant's two arguments above fails to rebut the *prima facie* showing of obviousness for the reasons discussed below.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 1:

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both inventions are in the same field: the Steel system has a capability of deleting the URL in their index if an error occurs in the central server or the sub server (paragraph 0082, 0094, and 0113 of Steel), and Glass teaches that the server will modify the broken link in order to restore the link or delete a record after a period of time (see col. 8, lines 43 – 48). It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the system of Glass by apply the teaching of Steel for deleting the web page from a search engine index because the combination would keep the record up-to-date, and reduce the time/cost searching for other user in later time (col. 7, lines 34 – 47 of Glass).

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In response to applicant's argument on the appeal brief, *a prima facie case of obviousness* is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

Reference is made to MPEP 2144.01 - Implicit Disclosure

"[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)

Subsequent to an analysis of the claims it was revealed that a number of limitations recited in the claims belong in the prior art and thus encompassed and/or implicitly disclosed in the reference (s) applied and cited. It is logical for the examiner to focus on the limitations that are "crux of the invention" and not involve a lot of energy and time for the things that are not central to the invention, but peripheral. The examiner is aware of the duties to address each and every element of claims, however, it is also important that a person prosecuting a patent application before the Office or an stakeholders of patent granting process make effort to

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understand the level of one of ordinary skill in the (data processing) art or the level one of skilled in the (data processing) art, as encompassed by the applied and cited references. The administrative convenience derived from such cooperation between the attorneys and examiners benefits the Office as well the patentee.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 2:

In response to appellant's argument, Appellant argues that Glass does not disclose, "receiving a notification by a search engine from a client browser that a Web page retrieval error occurred for a Web page or that the Web page no longer contains selected keywords". The Examiner respectfully disagrees.

This limitation is clearly disclosed in Fig. 2 – 3, col. 5, lines 35 – 40, col. 8, lines 61 – 65 of Glass. The "notification" corresponds to the message that is sent to the database by the search engine.

In response to appellant's argument, Appellant argues that Steele does not disclose: "automatically deleting the web page from the search engine indices". The Examiner respectfully disagrees.

Steel discloses a retrieving information system that allows a user view a website. Steel discloses a search engine that search the central index (paragraph 0073). In addition, plurality of remote servers also disclose, where each server contains an index (See Fig. 5, of Steel). The Steel system has a capability of deleting the URL in their index if an error (stale links) occurs in the central server or the sub server (paragraph 0082, 0094, and 0113 of Steel). Therefore, the Steele reference does disclose automatically deleting the web page from the search engine indices.

(11) Related Proceeding(s) Appendix

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent

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applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Nguyen, Cam Linh

LN

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

*Approved
Paul Sewell*

PAUL SEWELL
ACTING DIRECTOR

Conferees:

Chace Christian

Chace Christian

SPE- Art Unit 2161

Jeffrey Gaffin

SPE – Art Unit 2165

Jeffrey Gaffin